

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: February 2, 2004

Opposition No. 91123506
Cancellation No. 92031984
Cancellation No. 92032024
Cancellation No. 92032025

PUCEL ENTERPRISES, INC.

v.

GRIZZLY INDUSTRIAL, INC.

Cheryl Goodman, Interlocutory Attorney:

This case now comes up on Grizzly Industrial Inc.'s (hereinafter "Grizzly") motion to extend, filed December 16, 2002; Grizzly's motion to compel, filed December 30, 2002; and Grizzly's motion to amend, filed March 18, 2003.

In support of its motion, Grizzly argues that opposer, Pucel Enterprises, Inc. (hereinafter "Pucel") has provided inadequate responses to Interrogatory Nos. 5(d), 7, 8, 9, 10, 11, 12, 13, 15; and that Pucel has failed in its "duty to thoroughly search its records for all information properly sought in the request." Grizzly also complains about Pucel's written responses to Request for Production Nos. 1, 2, 3, 4, 5, 9, 11, 12, 13, 15, 16, 17, 18, 20, 21, and 22.

The Board turns first to the interrogatories in dispute.

Grizzly has essentially argued that Pucel's responses to the identified interrogatories are inadequate because they lack specificity, are incomplete, or that the documents referred to either have not been provided, or alternatively, that a time and date for inspection and copying of the documents has not been provided.

In response, Pucel argues that the interrogatories have been fully answered; that "additional or derivational inquiries are best made in a deposition"; that it provided Grizzly with two days at Pucel's business location to inspect and copy documents; and that, with the exception of third party advertisements for Grizzly Equipment, all documents with regard to the interrogatories have now been provided.

In reply, Grizzly argues that Pucel cannot "unilaterally decide to limit Grizzly to discovery by deposition or force Grizzly to guess what Pucel's responsive documents may be"; that Pucel's response that "Grizzly's interrogatories are 'questions best answered in deposition' is not an adequate response" to the interrogatories; that Pucel's interrogatory responses fail to identify the specific documents it has mentioned in its responses; that if Pucel believes documents are responsive to the

interrogatories, Pucel should supplement its interrogatory responses to refer specifically to these documents by document control number; and that Pucel cannot substitute a search by Grizzly through Pucel's documents to answer the interrogatories.

The Board will now consider the specific interrogatory requests.

Interrogatory No. 5(d)

The Board agrees with Grizzly that Pucel's response to this interrogatory is inadequate. In view thereof, Grizzly's motion to compel a better response to this interrogatory is granted to the extent that Pucel should identify with more specificity the "catalogs, various publications and websites" that provided Pucel's knowledge of the GRIZZLY trademark by supplying, for example, the title and date of the catalogs and publications and the internet addresses of the websites. Pucel has THIRTY DAYS from the mailing date of this order to serve its supplemental response.

Interrogatory No. 7

The Board finds that Pucel's response to this interrogatory is inadequate because Pucel has not specified the type of type distributors, dealers or end users. In view thereof, Grizzly's motion to compel a better response to this interrogatory is granted to the extent that Pucel

must specify the type of distributor, dealers or end users, (e.g., wholesale or retail distributor; wholesale or retail dealer etc.; consumer or enterprise end user etc.) Pucel has THIRTY DAYS from the mailing date of this order to serve its supplemental response.

Interrogatory No. 8

The Board finds that Pucel's response to this interrogatory is sufficient. The Board agrees with Pucel that Grizzly is requesting derivative or additional information that simply has not been asked for in this request, and the Board can make no reading of this interrogatory that requires such specificity (e.g., names, dates, circulation of directories and publications etc.) In view thereof, Grizzly's motion to compel with respect to this interrogatory is denied.

Interrogatory Nos. 9 and 10

Pucel has advised that it has provided a supplemental response to these interrogatories, and Grizzly states that "if Pucel were to amend its responses to Interrogatory Nos. 9 and 10 to incorporate this information and clarify that the columns reflect its advertising and promotion costs and its gross annual dollar sales, Grizzly would agree that the motion with respect to these two interrogatories is resolved."

In view thereof, Grizzly's motion to compel a better response to these interrogatories is granted to the extent that Pucel should supplement its response to Interrogatory Nos. 9 and 10 by providing a verified response that the supplemental response provided to Grizzly in document form containing information regarding advertising, promotion costs, and gross annual dollar sales comprises its supplemental written response to Interrogatory Nos. 9 and 10. Pucel has THIRTY DAYS from the mailing date of this order to serve its supplemental response.

Interrogatory No. 11

The Board finds that Pucel's response to this interrogatory is sufficient. The Board agrees with Pucel that Grizzly is requesting derivative or additional information that simply has not been asked for in this request, and the Board can make no reading of this interrogatory that requests trade name or company name use of the term GRIZZLY by third parties.

Interrogatory No. 12

The Board finds that Pucel's response is insufficient in that it does not provide the detail requested by the interrogatory.¹ In view thereof, Grizzly's motion to compel

¹ The Board finds this interrogatory vague in that use of the term "claim of rights" is unclear. The Board does not read this interrogatory to be requesting information regarding third party litigation as Grizzly is apparently asserting in its motion to compel.

a better response to this interrogatory is granted to the extent that Pucel should provide the specific information requested in the interrogatory, i.e., "name and address of each person or entity, explanation of all details, current status or disposition of claim, date of communication, persons involved etc." for each "claim of rights" and/or provide all documents from which this information can be derived. If the documents have already been provided, Pucel should so indicate in its written response and provide the document control numbers or other identifiable designations for these documents. Pucel has THIRTY DAYS from the mailing date of this order to serve its supplemental response.

Interrogatory No. 13

The Board finds Pucel's written response to this interrogatory sufficient in view of Pucel's statement that "documents which relate to these instances of actual confusion will be produced for inspection and copying." However, while Pucel has advised that it has since provided these documents, Grizzly, in its reply, disputes this statement. In view thereof, Grizzly's motion to compel a better response to this interrogatory is granted to the extent that if Pucel has not provided these documents, Pucel must provide all documents that relate to the instances of actual confusion identified in Interrogatory No. 13 for inspection and copying, and these documents must be either

labeled by control number or identified by box and location prior to the date of inspection and copying. To the extent that these documents have already been provided, Pucel must provide in writing a list of documents, clearly identified (by control number, if applicable or by other designation), which have already been provided to Grizzly which relate to Interrogatory No. 13 and must also advise Grizzly in writing that these documents constitute its complete response to Interrogatory No. 13. Pucel has THIRTY DAYS from the mailing date of this order to serve its supplemental response.

Interrogatory No. 15

Upon consideration of the parties' arguments with regard to this interrogatory, it is unclear to the Board whether Pucel has provided the documents or has identified which documents it has provided which are responsive to this interrogatory. In view thereof, Grizzly's motion to compel a better response to this interrogatory is granted to the extent that if Pucel has already provided the documents referred to in its response to this interrogatory, it must provide to Grizzly in writing a list of all documents previously provided (or identified by control number) that are responsive to this interrogatory and also state in writing that the documents already provided constitute its complete response to Interrogatory No. 15; to the extent

that Pucel has not yet provided the documents responsive to this request, Pucel must provide the referenced documents, along with a written response identifying all documents (by control number, if applicable or by list) responsive to this request. Pucel has **THIRTY DAYS** from the mailing date of this order to serve its supplemental response.

In summary, Grizzly's motion to compel better responses to its interrogatories is granted with respect to Interrogatory Nos. 5(d), 7, 9, 10, 12, 13, 15 to the extent indicated above; and Grizzly's motion to compel is denied with respect to Interrogatory Nos. 8 and 11. Grizzly has **THIRTY DAYS** from the mailing date of this order to serve its supplemental responses (as indicated above) to the interrogatories for which the motion to compel has been granted.

The Board now turns to the requests for production in dispute.

With regard to the document requests, Grizzly essentially argues that Pucel has not provided the control numbers of the documents; adequately identified the documents by box or location; has not provided certain confidential documents or identified documents withheld for privilege with a privilege log; and has not provided documents that it has in its possession which are also retained by the USPTO.

In response, Pucel states that it provided the following documents to Grizzly: Z0-Z408 and Z500-Z735; that it "opened its doors for two straight days for the inspection [of documents] but only one day was used by applicant for the inspection"; that it provided for inspection "200 bankers boxes which comprised 80,000 to 100,000 documents that were kept in the usual course of business"; that it has provided all documents "with the exception of third party advertisement [sic] of Grizzly Equipment"; and that Grizzly is not entitled to any relief with regard to the request for production since "all such information was provided to applicant during its inspection at the plant, and counsel for applicant apparently realizing that their overbroad request had been met, decided it was too much work to do the overbroad inspection."

In reply, Grizzly argues that Pucel's counsel's claim that the 200 boxes of documents Pucel provided contained other business documents is false since at the time of inspection the "designated boxes contained only invoices and internal product order forms"; that Pucel's counsel has refused to allow Grizzly's counsel to inspect any other documents, despite "acknowledging that he knew other relevant documents existed"; and that Pucel should identify which documents it has produced or is producing rather than expect Grizzly to identify them.

The Board now turns to the specific document requests.

Request for Production No. 4

With regard to Pucel's response to this request, it is unclear whether Pucel has copies of these documents in its possession. If Pucel has copies of these documents in its possession, it should provide them to Grizzly within THIRTY DAYS of the mailing date of this order; if Pucel does not have these documents in its possession, then it should so state in writing to Grizzly within THIRTY DAYS of the mailing date of this order. In the event these documents are not in Pucel's possession, Grizzly can obtain file wrappers and copies of registrations from USPTO records inasmuch as the burden on the parties to obtain the records is substantially the same, and Pucel has identified the location from which the file wrappers and copies of registrations can be obtained.²

Request for Production No. 5

The Board finds that Pucel did not provide a privilege log. In view thereof, Grizzly's motion to compel is granted to the extent that Pucel must provide a privilege log identifying any responsive documents being withheld with

² The granting of the motion to compel with regard to this Request for Production also relates to Request for Production No. 3 to the extent that the document request relates to copies of Pucel's trademark registrations.

respect to this request within THIRTY DAYS of the mailing date of this order.

Request for Production Nos. 1, 2, 3, 9, 13 18, 20, 21 and 22.

Although Pucel states it has provided all documents responsive to this request, it is unclear to the Board whether these documents have, in fact, been provided to Grizzly.

In view thereof, Grizzly's motion to compel is granted to the extent that Pucel must state in writing within THIRTY DAYS of the mailing date of this order whether it has provided all responsive documents with regard to Request for Production Nos. 1, 2, 3, 9, 13, 18, 20, 21 and 22, identify all documents already provided by their control number, and if additional documents have not yet been produced, identify the documents by their box and location and provide a date and time for inspection and copying, if needed.

Request for Production Nos. 11, 12, 15, 16 and 17

Although Pucel states it has provided all documents responsive to this request, it is unclear to the Board whether these documents have, in fact, been provided to Grizzly.

In view thereof, Grizzly's motion to compel is granted to the extent that Pucel must state in writing within THIRTY DAYS of the mailing date of this order whether it has

provided all responsive documents with regard to Request for Production Nos. 11, 12, 15, 16 and 17 and Pucel must identify all documents already provided by their control number.

In summary, Grizzly's motion to compel with regard to its request for production is granted to the extent indicated above, and Pucel has THIRTY DAYS from the mailing date of this order to serve its supplemental responses (as set forth above) to those requests.

The Board now turns to Grizzly's motion to extend.

Grizzly requests an extension of the discovery period by six months due to the need to make additional discovery requests and to depose additional witnesses.

In response, Pucel argues that a six-month extension is too long but it will consent to a three-month extension of discovery.

In reply, Grizzly argues that a six-month extension is needed due to "Pucel's slow and inadequate responses" to discovery and "attempting to resolve these deficiencies [in Pucel's discovery responses] without seeking the intervention of the Board" takes time.

Upon consideration of the parties' arguments, the Board finds good cause has been established for an extension of discovery and testimony periods. However in view of Pucel's objection to six-month extension, Grizzly's motion to extend

is granted to the extent that discovery will be extended by three months.³

The Board now turns to Grizzly's motion to amend.⁴ Grizzly filed on March 18, 2003, a motion to amend Registration No. 2413625⁵, and application Serial No. 76088346⁶ and Pucel has responded in opposition in part to the proposed amendments.

While Pucel does not object to the deletion of wording in Registration No. 2413625 and application Serial No. 76088346, Pucel objects to the addition of the language "for products for woodworking and metalworking, namely, services"

³ The Board notes that Grizzly took depositions of Pucel's 30(b)(6) witnesses in March 2003.

⁴ This is Grizzly's second request to amend one of the involved registrations. Grizzly also seeks to amend Registration No. 2312226; consideration of this request to amend has also been deferred until final decision.

⁵ Grizzly describes the amendment as follows: "Grizzly seeks to narrow the description of services offered in IC 035 to refer to "mail order services for products for woodworking and metal working, namely, services featuring The description of goods in IC 008 has similarly been limited to "woodworking and metal working hand tools, namely ... The description of goods in IC 009 is now limited to "[w]oodworking and metal working measuring equipment, namely, dial indicators, - dial calibrators, digital calipers and instruments, and measuring tapes; software, namely, software for disseminating information related to wood and metal working and wood and metal working equipment through a global information network; magnetic switches."

⁶ Grizzly describes the amendment as follows: "Grizzly seeks to narrow the description of the services so that the beginning of the description of the claimed services reads: Retail store services, online retail store services, and mail order services featuring products for woodworking and metal working namely services featuring:. . . . Grizzly also seeks to delete from this application "services featuring dollies, hand trucks, storage bins, tool tables, sliding tables, and material handling equipment, namely, carts, casters and wheels, mobile bases, outfeed tables and stands, roller stands, rollers, tables, and work stands."

with respect to Registration No. 2413625 and application Serial No. 76088346. Inasmuch as the amendments are one of substance and because the amendments have not been consented thereto, decision on the amendments are deferred until final decision.⁷ See TBMP Section 514.03 and cases cited therein. (2d. Ed. June 2003).

Proceedings are resumed. Discovery and trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE: **May 3, 2004**

30-day testimony period for party in position of plaintiff to close: **August 1, 2004**

30-day testimony period for party in position of defendant to close: **September 30, 2004**

15-day rebuttal testimony period for party in position of plaintiff to close: **November 14, 2004**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

⁷ The Board notes that no fee has been paid to amend this registration, but the request to charge the deposit account of Grizzly's counsel is noted.